REMARKS

Claims 2-22 and 24-44 are pending in the application.

Claims 2-22 and 24-44 have been rejected.

Claims 2 and 24 have been amended. No new matter has been added. The amendments to claims 2 and 24 have been made for clarification purposes.

Rejection of Claims under 35 U.S.C. § 101

Claims 2-22 and 24-44 stand rejected under 35 U.S.C. § 101 because the claimed invention is purportedly directed to non-statutory subject matter. Applicants respectfully traverse this rejection.

The Office Action purports that method claim 2 does not qualify as a 101 statutory process because claim 2 does not tie to an apparatus that accomplishes the method steps. *See* Office Action, p.2. As purported support for this rejection, the Office Action cites *In re Bilski*. The Office Action presents this rejection without any analysis of the claims. Applicants submit that this rejection is based on an incomplete reading of the *Bilski* decision.

Bilski recites a standard for analyzing certain method claims using a "machine-or-transformation" test to determine patentability under 35 U.S.C § 101. In particular, the Federal Circuit suggests a mechanism for determining whether a claim recites a "fundamental principle" and whether the claim would "pre-empt substantially all uses of that fundamental principle if allowed." *In re Bilski*, 2007-1130, at 10 (Fed. Cir. October 30, 2008). The Federal Circuit cites to the Supreme Court's decision in *Gottschalk v. Benson* as a means for determining whether a method claim is tailored narrowly enough to encompass only a particular application of a fundamental principle rather than to pre-empt the principle itself. "A claimed process is surely patent eligible under § 101 if: (1) it is tied to a particular machine or apparatus, <u>or</u> (2) it transforms a particular article into a different state or thing." *Id.* (citing *Benson*, 409 U.S. at 70) (emphasis added).

The Office Action relies only on the machine prong of the machine-or-transformation test. *See* Office Action, p.2. But a process that performs a transformation also satisfies the machine-or-transformation test and is "surely patent eligible under § 101." Applicants respectfully traverse this rejection because Claim 2 and dependent claims 3-22 do indeed

perform such a transformation. In *Bilski*, the Federal Circuit noted that data transformations of the type claimed are patentable. The Federal Circuit noted that "[w]e further note for clarity that the electronic transformation of the data itself ... was sufficient; the claim was not required to involve any transformation of the underlying physical object that the data represented." *In re Bilski* (citing *In re Abele*, 684 F.2d 902, 907, 214 USPQ 682, 687 (CCPA 1982) (emphasis added)). Applicants submit that the claimed receiving first data in a first format and the subsequent storing of the first data in an intermediate format is analogous to the favorably-noted transformation of data.

Claim 2 provides a method in which first data is received in a first format and second data is received in a second format. The first and second received data is then stored in an intermediate format. In this manner, the data in the first and second formats is transformed into data stored in an intermediate format. The data in the intermediate format is subsequently provided to a target system in a target format. Thus, the data undergoes yet another transformation from the intermediate format to the target format.

The transformations of data in Claim 2 are not mere extra-solution activity because the transformations are central to the claim. That is, if the transformation from a first and second format into an intermediate format and subsequent transformation from the intermediate format to the target format were not performed, the claim would lose meaning. As expressed in the Application, transformations to and from the intermediate format are desirable in order to avoid compatibility issues. Such transformations are further desirable to enable users to have the same view of enterprise information across the various computer applications. *See, e.g.*, Application, ¶¶ [0005], [0030], and [0031].

For the reasons discussed above, Applicants submit that independent claim 2 satisfies the test articulated in *In re Bilski* for determining patent eligibility of a process under § 101 and that claim 2 and all claims depending therefrom are in condition for allowance. Applicants therefore respectfully request the Examiner's reconsideration and withdrawal of the rejection of claims 2-22 and an indication of the allowability of same.

The Office Action has also rejected claims 24-44 under *In re Bilski*. The Office Action has provided no specificity regarding the rationale for this rejection. Applicants respectfully submit that *Bilski* cannot be used to reject claims 24-44 since these claims are directed toward a

computer-readable storage medium and not a method. As discussed above, *Bilski* is directed toward determining patentability of certain <u>method</u> claims.

In fact, the Board of Patent Appeals and Interferences has specifically addressed the issue of the patentability of *Beauregard* type claims, such as claims 24-44, in *Ex parte Bo Li*. The Board has held that claimed products embodied on computer readable media are statutory under § 101 in light of *In re Beauregard. See Ex parte Bo Li*, Appeal 2008-1213 (Bd. Pat. App. & Int'f 2008).

For at least these reasons, Applicants submit that independent claims 24 and all claims depending therefrom are patentable subject matter under § 101 and are in condition for allowance. Applicants therefore respectfully request the Examiner's reconsideration and withdrawal of the rejections to these claims and an indication of the allowability of same.

Rejection of Claims under 35 U.S.C. § 112

Claims 2-22 and 24-44 are rejected under 35 U.S.C. 112, second paragraph, as purportedly being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. Specifically, the Office Action objects to the use of "configured to" and "can be" in the claims. Without conceding to the validity of the rejection with regard to the phrase "can be," Applicants have amended independent claims 2 and 24 to overcome the Examiner's objections with respect to that phrase.

With regard to the objection of the use of the phrase "configured to," the Office Action has provided no support for this rejection. In fact, the weight of authority advocates just the opposite and that "configured to" is acceptable claiming terminology. "There is nothing inherently wrong with defining some part of an invention in functional terms. Functional language does not, in and of itself, render a claim improper." MPEP § 2173.05(g), citing *In re Swinehart*, 439 F.2d 210, 169 USPQ 226 (CCPA 1971). This is most appreciably illustrated by the 76,691 patents containing the language "configured to" in a claim and the 343,332 patents containing the language "adapted to" in a claim that have been issued since Hutchison was decided (search of USPTO database for patents issued between 1/1/1947 and 10/24/2000 performed on Oct. 24, 2000). Furthermore, in cases such as *State Street Bank & Trust Co. v.*

Signature Financial Group Inc., claims have been found valid despite their use of the language "configured to." *See State Street Bank*, 47 USPQ2d 1596 (Fed. Cir. 1998). Applicants further note that no ambiguity is introduced in the present claims by providing the claimed common objects are functionally configured to pass data. A common object would either perform the stated function or it would not.

For at least these reasons, Applicants submit that claims 2-22 and 24-44, as amended, are allowable over 35 U.S.C. § 112, para. 2. Applicants therefore respectfully request the Examiner's reconsideration and withdrawal of the rejections of these claims and an indication of the allowability of same.

<u>*Rejection of Claims under 35 U.S.C. § 103*</u>

Claims 2 and 24 stand rejected under 35 U.S.C. §103(a) being unpatentable by Block, U.S. Patent No. 6,947,947 ("Block") in view of Hougaard et al., U.S. Patent No. 6,974,947 ("Hougaard"). Applicants respectfully traverse this rejection.

Independent claims 2 and 24, as amended, contain limitations of substantially the following form:

> managing enterprise data, wherein said managing enterprise data comprises
> > receiving first data in a first format from a first source system;
> > receiving second data in a second format from a second source system, wherein
> > > the second format is distinct from the first format;
> > storing the first data and the second data in an intermediate format, wherein
> > > the intermediate format is defined by a plurality of common objects configured to pass data from the first and second source systems to a target system,
> > > the intermediate format comprises a schema defining a plurality of common data type elements accessible by each of the plurality of common objects,
> > > a data element defined by one of the common data type elements has a consistent structure in each common object using that data element,
> > > one or more of the common data type elements are reusable data structures that are referenced by other intermediate data structures, and
> > > said storing comprises mapping the first data and the second data to the intermediate format using one or more of the common data type elements; and

> providing the stored first data and second data to the target system in a
> target format.

See, *e.g.*, claim 2 (as amended). Applicants respectfully submit that the cited sections of Block fail to teach or contemplate at least "receiving first data in a first format from a first source system" and "receiving second data in a second format from a second source system" because Block transmits data in an intermediate format from system to system.

With respect to the "receiving first data in a first format from a first source system" limitation, the Office Action cites the following passage of Block:

> In accordance with an embodiment of the invention, data output from a first computer platform or system can be automatically <u>converted by a software module on the first platform</u>, from a first format into an intermediate format, transferred to a second platform or system, and then converted from the intermediate format into a second format by a second software module on the second platform.

Block, 4:23-28 (emphasis added). This passage of Block shows a system with two platforms, a first platform and a second platform. The first platform in Block converts data to an intermediate format before sending to the second platform and the second platform on receiving the intermediate data converts it to a target format. Applicants submit that because Block converts from a first format to an intermediate format <u>on the first platform</u>, it cannot be said that Block teaches the "receiving first data in a first format from a first source system" limitation. Block converts from first data to intermediate data on the first platform; therefore Block's system transmits intermediate format data.

Even if the Office Action intends Block's reception of data in Block's intermediate format to correlate with the claimed "receiving first data in a first format," Block cannot then be said to provide disclosure of the claimed "receiving second data in a second format ... wherein the second format is distinct from the first format." This is because, as discussed above, Block converts data into an intermediate format on the transmitting system, and therefore any data received from the second system will be <u>in the same format</u> as that received from the first system. This is consistent with Block's stated goal of providing "transparent exchange" of data between platforms regardless of whether the locally used formats on those systems are compatible. *See*, *e.g.*, Block 4:28-33. Any other result would be contrary to Block's stated purpose and design (and therefore contrary to the standard for finding obviousness).

By contrast, claim 2 provides for a node receiving data in a first format from a first system and in a second, distinct format from a second system (e.g., the data is not converted to an intermediate format on the source system). That data, received in distinct formats, is then stored in the described intermediate format, and then provided to a target system in a target format. Thus, a transformation of the received first and second formatted data is performed to the intermediate format, and then another transformation of the intermediate formatted data is performed to a target format prior to providing that target formatted data to the target system.

Hougaard is not cited as disclosing anything pertaining to the "receiving" features and therefore Hougaard is unable to cure the deficiency that Block suffers in teaching or contemplating this feature. Thus, neither Hougaard nor Block alone or in any combination teach or suggest all of the elements of claims 2 and 24.

For at least these reasons, Applicants submit that neither Block nor Hougaard, alone or in combination, provide disclosure of all the limitations of independent claims 2 and 24, and all claims depending therefrom, and that these claims are in condition for allowance. Applicants therefore respectfully request the Examiner's reconsideration and withdrawal of the rejections to these claims and an indication of the allowability of same.

Claims 3-22 and 25-44 stand rejected under 35 U.S.C. §103(a) purportedly being unpatentable by Block, in view of Hougaard and further in view of Guyan et al., U.S. Patent No. 7,124,112 ("Guyan"). Applicants respectfully traverse this rejection.

Claims 3-22 depend on independent claim 2, and claims 25-44 depend on independent claim 24. Applicants respectfully submit that dependent claims 3-22 and 25-44 are in condition for allowance for at least the foregoing reasons set forth with respect to the independent claims. Applicants therefore respectfully request the Examiner's reconsideration and withdrawal of the rejections to these claims and an indication of the allowability of same.

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CONCLUSION

Applicants submit that all claims are now in condition for allowance, and an early notice to that effect is earnestly solicited. Nonetheless, should any issues remain that might be subject to resolution through a telephonic interview, the Examiner is requested to telephone the undersigned.

If any extensions of time under 37 C.F.R. § 1.136(a) are required in order for this submission to be considered timely, Applicants hereby petition for such extensions. Applicants also hereby authorize that any fees due for such extensions or any other fee associated with this submission, as specified in 37 C.F.R. § 1.16 or § 1.17, be charged to deposit account 502306.

Respectfully submitted,

/Jonathan N. Geld/

Jonathan N. Geld
Attorney for Applicants
Reg. No. 44,702
(512) 439-5090 [Phone]
(512) 439-5099 [Fax]